

Remarks

The Rejection of Claims 16, 17, 27, 28, 35, 36, 41, 42, 46-50, 70, 71, 81, 82, 89, 90, 96, 97, and 102-107 Under 35 U.S.C. §112

The Examiner rejected Claims 16, 17, 27, 28, 35, 36, 41, 42, 46-50, 70, 71, 81, 82, 89, 90, 96, 97, and 102-107 under 35 U.S.C. §112, first paragraph, as failing to comply with the enabling requirement. The Examiner also rejected the aforementioned claims under 35 U.S.C. §112, second paragraph as failing to point out and distinctly claim the subject matter which Applicant regards as the invention. For both rejections, the Examiner cited the following claim limitation: "...transmitting to said client a notice of time remaining to file a patent application under applicable law on matter incorporated in said product..."

Applicants have cancelled original Claims 1 through 114 and added new Claims 115 through 133. The new claims do not contain the above-referenced limitation. New Claim 124 recites "...further comprising the step of sending a reminder notice regarding a one-year anniversary date for said date of first publication." Applicants respectfully submit that the limitation recited in new Claim 124 does not require the present invention system to understand or have knowledge of, a priori, the "invention" disclosed in the product document. Applicants respectfully submit that these amendments overcome the rejection under 35 U.S.C. §112, and reconsideration is requested.

The Rejection of Claims 1, 10-12, 15, 18, 21-23, 26, 29, 40, 43, 51, 56, 65-67, 69, 72, 75-78, 80, 83, 86, 95, 98, 101, 108, and 111 Under 35 U.S.C. §102

The Examiner rejected Claims 1, 10-12, 15, 18, 21-23, 26, 29, 40, 43, 51, 56, 65-67, 69, 72, 75-78, 80, 83, 86, 95, 98, 101, 108, and 111 as being anticipated by United States Patent No. 5,659,742 (Beattie, et al) under 35 U.S.C. §102(b). Applicants have cancelled original Claims 1 through 114 and added new Claims 115 through 133. New Claim 115 recites "...receiving said product document; digitally notarizing said product document to create a document notarization record, where said document notarization record includes a publication date/time stamp..." New Claim 129 recites "...means for receiving said product document; means for digitally notarizing

Attorney Docket No. 000308US
U.S. Patent Application No. 09/661,009
Amendment and Request for Reconsideration dated: February 10, 2004
Reply to Office Action of September 10, 2003

said received product document to create a document notarization record, where said document notarization record includes a publication date/time stamp...” Therefore, Claims 115 and 129 both recite digitally notarizing a product document received by the present invention. *Beattie, et al.*; do not disclose this element. Rather, *Beattie, et al.* disclose the entirely different step of providing a time stamp with respect to accessing documents already received and stored by the *Beattie, et al.* invention. For example, in col. 35, lines 62-65, *Beattie, et al.* state: “Additionally, the accounting record 119c contains a time stamp indicating the time of *access of the document by a user station 102* (emphasis added) and a link to the subscriber profile information in the subscriber profile database 119a.” Also, col. 36, lines 41-44: “The data center 110 can also provide time profiles such as time profiles per session, time profiles per week and time profiles on the think time required by the users.” The above excerpts from *Beattie, et al.* show that the focus of the time stamping is completely on user activities and ignores the aspects of the system related to receiving documents.

Neither do *Beattie, et al.* suggest or motivate time stamping incoming publisher documents. *Beattie, et al.* teach formatting and organizing incoming publisher documents (col. 26, line 25 to col. 31, line 40). However, *Beattie, et al.* do not teach time stamping or other means of recording when documents enter their invention system. Further, *Beattie, et al.* do not suggest that time stamping or other means of recording when documents enter their invention system is feasible, desirable, or necessary.

Since *Beattie, et al.* fail to describe all the limitations of the invention of new Claims 115 and 129, the Applicant respectfully requests that the rejection be removed. New Claims 116 through 128 dependent from Claim 115, also benefit from the above-mentioned distinctions. New Claims 130 through 133 dependent from new Claim 129 also benefit from the above-mentioned distinctions.

Attorney Docket No. 000308US
U.S. Patent Application No. 09/661,009
Amendment and Request for Reconsideration dated: February 10, 2004
Reply to Office Action of September 10, 2003

The Rejection of Claims 2-9, 13, 14, 16, 17, 19, 20, 24, 25, 27, 28, 30-39, 41, 42, 44-50, 52, 53-55, 57-64, 68, 70, 71, 73, 74, 79, 81, 82, 84, 85, 87-94, 96, 97, 99, 100, 102-107, 109, 110, and 112-114 Under 35 U.S.C. §103

The Examiner rejected Claims 2-9, 13, 14, 16, 17, 19, 20, 24, 25, 27, 28, 30-39, 41, 42, 44-50, 52, 53-55, 57-64, 68, 70, 71, 73, 74, 79, 81, 82, 84, 85, 87-94, 96, 97, 99, 100, 102-107, 109, 110, and 112-114 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,659,742 (Beattie, et al.). Applicants have cancelled original Claims 1 through 114 and added new Claims 115 through 133. New Claims 116 through 128 depend from new Claim 115 and new Claims 130-133 depend from new Claim 129.

Applicants respectfully submit that *Beattie, et al.* do not suggest or motivate all of the elements of the invention recited in new Claims 115 and 129, as discussed above for the 35 U.S.C. §102(b) rejections. Neither has the Examiner established a reasonable expectation of success. Finally, *Beattie, et al.* do not teach or suggest all the claim limitations of new Claims 115 or 129, as discussed above for the 35 U.S.C. §102(b) rejections. Specifically, *Beattie, et al.* do not teach or suggest "...digitally notarizing said product document to create a document notarization record, where said document notarization record includes a publication date/time stamp."

Hence, *Beattie, et al.* fail to satisfy the three requirements for establishing a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejections be removed. New Claims 116 through 128 dependent from new Claim 115, also benefit from the above-mentioned distinctions. New Claims 130 through 133 dependent from new Claim 129 also benefit from the above-mentioned distinctions.

Attorney Docket No. 000308US
U.S. Patent Application No. 09/661,009
Amendment and Request for Reconsideration dated: February 10, 2004
Reply to Office Action of September 10, 2003

Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

CPM
Dated: February 10, 2004